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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,465	03/01/2004	Stephen P. Dulac	PD-202096	9946
31625	7590	08/10/2006	EXAMINER	
BAKER BOTTS L.L.P. PATENT DEPARTMENT 98 SAN JACINTO BLVD., SUITE 1500 AUSTIN, TX 78701-4039				LEWIS, CHERYL RENEA
			ART UNIT	PAPER NUMBER
			2167	

DATE MAILED: 08/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/790,465	DULAC, STEPHEN P.
	Examiner	Art Unit
	Cheryl Lewis	2167

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### **Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 01 March 2004.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-39 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 1-39 is/are rejected.  
7)  Claim(s) \_\_\_\_\_ is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 01 March 2004 is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3/1/04.

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_

5)  Notice of Informal Patent Application (PTO-152)

6)  Other: \_\_\_\_\_

**DETAILED ACTION**

1. Claims 1-39 are presented for examination.

**INFORMATION DISCLOSURE STATEMENT**

2. The information disclosure statements filed on March 1, 2004, complies with the provisions of MPEP § 609. They have been placed in the application file, and the information referred to therein has been considered as to the merits.

***Priority***

3. Receipt is acknowledged of a certified copy of the German Patent Application, DE 101 43 502.9 application referred to in the oath or declaration or in an application data sheet. If this copy is being filed to obtain the benefits of the foreign filing date under 35 U.S.C. 119(a)-(d), applicant should also file a claim for such priority as required by 35 U.S.C. 119(b). If the application being examined is an original application filed under 35 U.S.C. 111(a) (other than a design application) on or after November 29, 2000, the claim for priority must be presented during the pendency of the application, and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application. See 37 CFR 1.55(a)(1)(i). If the application being examined has entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the claim for priority must be made during the pendency of the

application and within the time limit set forth in the PCT and Regulations of the PCT. See 37 CFR 1.55(a)(1)(ii). Any claim for priority under 35 U.S.C. 119(a)-(d) or (f) or 365(a) or (b) not presented within the time period set forth in 37 CFR 1.55(a)(1) is considered to have been waived. If a claim for foreign priority is presented after the time period set forth in 37 CFR 1.55(a)(1), the claim may be accepted if the claim properly identifies the prior foreign application and is accompanied by a grantable petition to accept an unintentionally delayed claim for priority. See 37 CFR 1.55(c).

The applicant has filed a copy of a submission of foreign priority to German Patent Application, DE 101 43 502.9 on May 17, 2004. However, no claim for foreign priority has been made by the applicant nor has there been any establishment of foreign priority by the applicant.

Again, the submission of the priority made on May 17, 2004 to German Patent DE 101 43 502.9 has indicated that the priority has been made to this instant application (10/790465) and has a different inventor listed than the inventor cited for this instant application. The inventor for this application and listed on the oath for this instant application is Stephen P. Dulac. The cited inventor for the document that mentions the German Patent is Joachim Melber.

For the convenience of the applicant the examiner has attached a copy of the oath and a copy of the submission of foreign priority. Upon reviewing these two documents, the applicant will be able to find the discrepancy made to this application.

***Drawings***

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: The reference numerals of figures 1-3 are not mentioned in the Specification. In fact the reference numerals for figures 1-3 are not the same reference numerals listed in the Specification. Drawing figures 1-3 do not match figures 1-6 listed in the Specification.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the figure elements of drawing figures 1-6 have not been provided. The applicant has only submitted drawing figures 1-3. The drawing figures and drawing figure element for figures 1-6 mentioned in the Specification are not in the drawings. Therefore, the drawings must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

6. The disclosure is objected to because of the following informalities: The specification has been objected to because the brief description of the drawings include a reference to drawing figures 1-6 and the detailed description of the application gives a detailed description of figures 1-6 and the figure elements comprised within drawing figures 1-6. The specification does not match the drawings, drawing figures 1-3.

Appropriate correction is required.

***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 1, 14, and 27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

**MPEP 2106 IV.B.2.(b)**

A claim that requires one or more acts to be performed defines a process. However, not all processes are statutory under 35 U.S.C. 101. Schrader, 22 F.3d at 296, 30 USPQ2d at 1460. To be statutory, a claimed computer-related process must either: (A) result in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan, or (B) be limited to a practical application within the technological arts.

9. Claims 1, 14, and 27 are not statutory because the claims do not produce a tangible result.

The body of the claim does not recite any of the tangible steps listed in the preamble that would make these claim statutory. The preamble recites collecting (1), storing (2), and processing (3). These steps are tangible embodiments. However, the body of the claim does not recite any of these tangible embodiments. In fact, the claim limitations should comprise a descriptive functionality of collecting, storing, and processing in an effort to make these claims statutory. Simple put, these embodiments will cause the claims to produce tangible results.

10. Claims 1, 14, and 27 are not limited to tangible embodiments. In view of the applicant's disclosure, specification page 18, paragraph 0061, the medium is not limited to tangible embodiments, instead being defined as including both tangible (e.g., RAM)

and intangible embodiments (e.g., carrier wave, modulated data signal). As such, the claims are not limited to statutory subject matter and are therefore non-statutory.

***Claim Rejections - 35 USC § 112***

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 1, 14, and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 14, and 27 recite "obfuscating". Webster's dictionary defines "obfuscating" as a means to make dark or obscure; to confuse. What is meant by "obfuscating, but not eliminating, the customer identifier from the extracted usage data"?

***Claim Rejections - 35 USC § 102***

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

14. Claims 1-39 are rejected under 35 U.S.C. 102(e) as being anticipated by Engberg (Publication No.: US 2003/0158960 A1 filed November 22, 2002, provisional application No. 60/206,565, filed May 23, 2000).
15. Regarding Claims 1, 14, and 27, Engberg teaches a system and method for establishing a privacy communication path. The method and associated system for establishing a privacy communication path as taught or suggested by Engberg includes:
  - extracting the usage data from the device (paragraphs 0388-0390), wherein the usage data is associated with a customer identifier (paragraph 0257-0259 and 0275); obfuscating, but not eliminating, the customer identifier from the extracted usage data (paragraph 0257-0259, 0275-0278, and 0312-0332); and correlating the extracted usage data over a period of time using the obfuscated customer identifier (paragraph 0257-0259, 0275-0278, and 0312-0332).
16. Regarding Claims 2, 15, and 28, Engberg teaches the usage data is processed in accordance with a privacy policy recorded for each customer (paragraphs 0155, 0163, 0386, and 0389).
17. Regarding Claims 3, 16, and 29, Engberg teaches both the customer identifier and the usage data are stored for “opt-in” customers (paragraphs 0227-0920).
18. Regarding Claims 4, 17, and 30, Engberg teaches the obfuscated customer identifier and the usage data are stored for “opt-neutral” customers (paragraphs 0227-0920).
19. Regarding Claims 5, 18, and 31, Engberg teaches neither the customer identifier nor the usage data are stored for “opt-out” customers (paragraphs 0227-0920).

20. Regarding Claims 6, 19, and 32, Engberg teaches extracted usage data associated with an “opt-neutral” customer (paragraphs 0227-0920).
21. Regarding Claims 7, 20, and 33, Engberg teaches creating a replacement identifier for the customer identifier from the extracted usage data (paragraphs 0227-0920).
22. Regarding Claims 8, 21, and 34, Engberg teaches translating the customer identifier from the extracted usage data into the replacement identifier (paragraphs 0227-0920).
23. Regarding Claims 9, 22, and 35, Engberg teaches a translation function that produces a unique replacement identifier for every customer identifier (paragraphs 0227-0920).
24. Regarding Claims 10, 23, and 36, Engberg teaches a translation function that produces a non-unique replacement identifier for every customer identifier (paragraphs 0227-0920).
25. Regarding Claims 11, 24, and 37, Engberg teaches a one-way translation function that has an inverse function that is difficult to perform (paragraphs 0227-0920).
26. Regarding Claims 12, 25, and 38, Engberg teaches the device sends the viewing usage data along with a usage identifier that is independent of the customer identifier (paragraphs 0227-0920).
27. Regarding Claims 13, 26, and 39, Engberg teaches translating the customer identifier from the extracted usage data into a replacement identifier using the usage identifier (paragraphs 0227-0920).

**NAME OF CONTACT**

28. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Lewis whose telephone number is (571) 272-4113. The examiner can normally be reached on 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cottingham can be reached on (571) 272-7079. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

(571) 273-4113 (Use this FAX #, only after approval by Examiner, for "INFORMAL" or "DRAFT" communication. Examiners may request that a formal paper/amendment be faxed directly to them on occasions.).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/ Technology Center (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

Should you have questions on access to the Private PAIR system, contact the  
Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Cheryl Lewis  
Patent Examiner  
August 7, 2006